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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROYUKI NAITOU
and TAKASHI KARASUDA

Appeal 2009-004954
Application 10/519,407
Technology Center 1700

Oral Hearing Held: July 8, 2009

Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and KAREN M. HASTINGS, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

HARRIS A. PITLICK, ESQUIRE
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ALSO PRESENT:

Cheryl Moore

1 The above-entitled matter came on for hearing on Wednesday,
2 July 8, 2009, commencing at 9:05 a.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Paula L. Lowery,
4 Notary Public.

5 THE CLERK: Good morning. Calendar Number 16, Appeal No.
6 2009-4954, Mr. Pitlick.

7 JUDGE TIMM: Good morning, Mr. Pitlick.

8 MR. PITLICK: Good morning.

9 JUDGE TIMM: As you know, you have 20 minutes. If you would
10 state your name for the record for our court reporter.

11 MR. PITLICK: My name is Harris Pitlick. I have a business card for
12 the reporter.

13 JUDGE TIMM: You may begin when you're ready.

14 MR. PITLICK: Before I start, just a housekeeping issue. The Board,
15 in an order dated March 12, 2008, order returning of undocketed appeal to
16 Examiner because one of the references was a Japanese reference, and there
17 was an English-machine translation in the record.

18 We've never received a traditional translation. It doesn't matter to us
19 because its reference, actually, which I'll get to shortly, is one of ours; and
20 it's a reference the Examiner has rejected over.

21 Just out of curiosity, more than anything else, I'd like to know whether
22 or not the Board received a copy of this reference.

23 JUDGE GAUDETTE: Yes, we have a copy -

24 MR. PITLICK: Okay.

25 JUDGE GAUDETTE: -- of the translation.

26

1 MR. PITLICK: I guess I'll have to go check PAIR again, but I don't
2 believe we've received a copy.

3 At any rate there's one issue here, and that's whether the present
4 claims are unpatentable under 35 USC Sec. 103(a) over this Naito that I'll
5 reference.

6 The present invention is an improvement over Naito, et al. The
7 invention involves mixing three different solutions or slurries of defined
8 composition.

9 What applicants have discovered is if you mix what we call
10 composition B with either A or C, or the combination of A and C over a
11 particular time range -- when I say mixing, we've indicated in the Appeal
12 Brief, and it's not controversial, that we're talking about the time in which
13 this composition B is added to the A, the C, or the combination of A and C.

14 This is a result-effective variable, and the catalyst that is made by this
15 particular process results in greater selectivity and conversion when the
16 catalyst is used to form methacrylic acid from the catalytic oxidation
17 methacryl.

18 The reference Naito, et al. also has the same three compositions, but
19 what the invention of the reference is that you have to mix A and B together
20 and add that to C.

21 Now, there are a couple of embodiments. You can add A into B, or B
22 into A, but the bottom line is you have to have A and B together, and you
23 mix it with C.

24 So as we've argued in the Appeal Brief and Reply Brief, there's no
25 prima facie case of obviousness here. One reason, it was not known that this
26 additional mixing time was going to affect the variable.

1 So, one, it hasn't been shown to be a result-effective variable. Plus,
2 we've also shown superior results, which the Examiner really has not
3 disputed at all.

4 We've also shown, for example, that Example 8 of Naito, et al. is the
5 same as our comparative Example 4.

6 The reason we put that in there is because Naito does not disclose
7 what the mixing or addition time was in that example. We've shown that it
8 was actually 30 minutes. It was outside the range of our claims.

9 But at least some of the examples in the prior examples which you
10 talked about, everything was identical except the mixing or adding time of
11 B, and we've shown greater result.

12 Also, which we talked about in the Brief, we've actually shown that if
13 you use the order of addition that Naito talks about as something that you
14 don't do -- in other words, for example, A plus C and then B, or something
15 other than A plus B and then C -- if you do that but yet add B within the
16 terms of our claim, you'll actually get a much superior result.

17 So that's our case in a nutshell. I'll be happy to try and answer any
18 questions that you may have.

19 JUDGE TIMM: Do you have any questions?

20 JUDGE GAUDETTE: No.

21 JUDGE HASTINGS: No.

22 JUDGE TIMM: No questions.

23 MR. PITLICK: Thank you.

24 JUDGE TIMM: We're off the record.

25 Whereupon, the proceedings at 9:10 a.m. were concluded.